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08/274,942 07/14/94 HAGMANN

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EXAMINER  
VARGOT, M

ART UNIT PAPER NUMBER

6

1307

DATE MAILED:

04/16/96

MICHAEL W. GLYNN  
PATENT DEPARTMENT  
CIBA GEIGY CORPORATION  
520 WHITE PLAINS ROAD, P.O. BOX 2005  
TARRYTOWN, NY 10591-9005

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 1/16/96 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-5, 8-40, 42-61 + 63-81 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☒ Claims 6, 7, 41 + 62 have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-5, 8-40, 42-61 + 63-81 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-61, drawn to a method and device for the manufacture of moldings, classified in Classes 264 and 425, subclasses 1.38 and 174.4.

II. Claim 62, drawn to a molding, classified in Class 351, subclass 160R.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as method and apparatus for the making of a product and product made. The inventions are submitted as separate or distinct in that the instant molding can be made by other and materially different processes and apparatus, such as those not using a source of energy to cure the material (ie, the material can be cured thermally).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Meece on September 7, 1995 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-41. Affirmation of this election must be made by applicant in responding to this

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Office action. Claim 42 has been withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

2. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- (c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the invention.
  - 1. Field of the Invention.

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2. Description of the Related Art including information disclosed under 37 C.F.R. §§ 1.97-1.99.

- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (i) Abstract of the Disclosure.

3. Claims 22, 25, 56 and 58 are objected to under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See M.P.E.P. § 608.01(n). Accordingly, these claims and claims 26 and 59 dependent thereon have not been further treated on the merits.

4. Claims 1-21, 23, 24, 27-55, 57, 60 and 61 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 40, lines 1-2, the recitation "especially optical lenses, specifically contact lenses" is indefinite in specifying a preferred embodiment (not once, but twice) that renders the metes and bounds of the claims uncertain. Applicant should delete the "especially" and "specifically" language in the claims and instead draft new dependent claims covering any preferred limitations. Claims 1 and 40 should contain a recitation to producing a crosslinked molding in that the dependent claims which set forth such a molding lack antecedent basis for this element. Also, the starting material should be positively

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identified as a polymeric or plastic resin material in claims 1 and 40 for clarity. Claim 3 is rejected for reasons set forth with respect to claims 1 and 40. All the claims should be carefully reviewed by applicant and the recitations of "especially...", "particularly...", "specifically...", etc deleted and set forth in additional dependent claims. See eg. claim 7, claim 30 (last line), claim 31 (last two lines) and claim 33 (last two lines), the occurrences of the "preferably..." and "especially preferably..." clauses need to be corrected in that they render the metes and bounds of the claims uncertain as noted supra. Claims 13 and 49, does applicant intend that the molds themselves (and hence the mold cavity) is immersed in the starting material?

Concerning the apparatus claims, claims 40 and 49 are rejected for reasons noted supra. Also, in claim 47, a recitation that the "cavity is arranged in starting material" is indefinite in that a mold cavity only exists when two molds cooperate to create same. Applicant should recite language as to the relationship of the molds themselves during the filling, not the mold cavity. See also claims 43, 44 and 45 concerning the preferred limitations clauses.

5. Claims 1-4, 6, 8-10, 12-17, 20, 27-29, 40, 41, 46-51, 54, 60 and 61 are rejected under 35 U.S.C. § 102(b) as being anticipated by Clark et al. Clark et al discloses the instant method and

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apparatus for manufacturing a contact lens including a step and means of curing the lens material with energy (col. 6, line 51) wherein the filling of the mold cavity is carried out "in the starting material". Clark et al provides a reservoir which surrounds the mold cavity in which starting material is contained and it is submitted that this reservoir has starting material which "floods" the mold cavity, as the amount contained therein is in excess of that required to fill the cavity. In fact, the excess is at least as great as the amount required to flow back into the cavity during the curing to compensate for the shrinkage. See column 59-64. The molds are closed "in the starting material", female mold member 15 constitutes a container having a female molding surface (41), and the male mold (13) is displaceable. It is submitted that the mold arrangement shown in Clark et al is at least readable on instant claim 52 and the method of using it in claim 17. Concerning the mask, see 141 in Fig. 3; concerning the spacers, see 131 in Fig. 3. For the parallel beam of radiation, see col. 7, line 28.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 7, 11, 18, 19, 21, 23, 24, 30-39, 42-45, 52, 53, 55 and 57 are rejected under 35 U.S.C. § 103 as being unpatentable over Clark et al. The applied reference has been discussed in paragraph 5, supra, and discloses the basic claimed method and apparatus lacking essentially pumps to feed in the material and either a gripper or flushing out of the mold cavity to remove the lens. Clark et al teaches depositing the material into the cavity (col. 4, line 23) and a pump would facilitate such a deposition. Grippers to remove products are nothing but conventional in the art and would have been an obvious feature in Clark et al. Likewise, using a flow of fresh starting material between the molds of Clark et al to remove the cured lens is submitted as obvious in that such would facilitate the subsequent loading. The aspect of providing the male mold on the container (instead of the female mold as taught in Clark et al) is submitted as obvious dependent on relative location of the mold pieces desired. Such merely involves a rearrangement of the parts of Clark et al. The exact materials used as set forth in instant claims 30-38 would have been obvious material selections

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in the process of the applied reference dependent on the exact properties desired for the lens. Note that Clark et al places the mask externally to the mold halves. It would have been entirely obvious to one of ordinary skill in the art at the time of invention to have placed the mask on the mold halves (ie, between the parting line/separating plane of the mold halves) as such merely constitutes a rearrangement of parts that would have been within the skill level of the art. Washing the mold halves with a solvent to remove any traces of starting materials before commencing another molding cycle as set forth in instant claim 11 is nothing but conventional in the art and would have been obvious in Clark et al to prevent contamination. Likewise, the limitation of instant claim 39 is nothing but conventional and would have been obvious to facilitate the additional handling (such as hydration or sterilization) required prior to shipping the lens.

7. Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Clark et al in view of European Patent Application 484,015. Clark et al has been discussed in paragraphs 5 and 6, supra, and discloses the basic claimed method lacking essentially using a mold made of parts that have different permeabilities to the crosslinking energy. European -015 teaches this (page 5, lines 16-26). It would have been obvious to one of ordinary skill in the art at the time of



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invention to have utilized a mold as taught by European -015 in lieu of (or in addition to) the masking procedure in Clark et al to further ensure that the starting material around the mold cavity remained flowable (uncured).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Neefe discloses molding a plastic lens by floating a convex mold upon material filled into a concave mold and curing the material under heat and pressure. Hara discloses molding a glass article using a container which is filled with molten glass and functions as a mold itself. Grucza (11f in Fig. 1) teaches a breakaway mold piece in forming a contact lens blank. Portney et al is cited as of interest.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is (703) 308-2621.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

M. Vargot

September 27, 1995

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300  
9/27/95